

## United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE		FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
09/970,122		10/02/2001	Hou-Pu Chou	020174-002510US 2108		
20350	7590	12/01/2004		EXAMINER		
TOWNSEN TWO EMBA	ND AND ARCADEI	TOWNSEND ANI RO CENTER	PHASGE,	PHASGE, ARUN S		
EIGHTH FL	OOR		ART UNIT	PAPER NUMBER		
SAN FRAN	CISCO, C	CA 94111-3834	1752			

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.						
		·	Applicant(s)					
	Office Action Summary	09/970,122	CHOU ET AL.					
	omeo notion cammary	Examiner	Art Unit					
	The MAILING DATE of this communication and	Arun S. Phasge	1753					
Period f	The MAILING DATE of this communication app or Reply	ears on the cover sheet with the c	orrespondence address					
- External control con	MORTENED STATUTORY PERIOD FOR REPLY MAILING DATE OF THIS COMMUNICATION. ensions of time may be available under the provisions of 37 CFR 1.13 or SIX (6) MONTHS from the mailing date of this communication. e period for reply specified above is less than thirty (30) days, a reply of period for reply is specified above, the maximum statutory period with uncertainty the set or extended period for reply will, by statute, reply received by the Office later than three months after the mailing and patent term adjustment. See 37 CFR 1.704(b).	6(a). In no event, however, may a reply be tim within the statutory minimum of thirty (30) days ill apply and will expire SIX (6) MONTHS from t	ely filed will be considered timely. the mailing date of this communication.					
Status								
1)	Responsive to communication(s) filed on							
2a)[	This action is <b>FINAL</b> . 2b) This action is non-final.							
3)	3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is							
closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.								
Disposit	ion of Claims							
	Claim(s) <u>1-33</u> is/are pending in the application. 4a) Of the above claim(s) is/are withdraw	n from consideration.						
	5) Claim(s) is/are allowed.							
	6) Claim(s) is/are rejected.							
	Claim(s) is/are objected to. Claim(s) <u>1-33</u> are subject to restriction and/or ele	oation manufacture						
		ection requirement.						
	on Papers							
9) 🗌 🤈	The specification is objected to by the Examiner.							
10)[	The drawing(s) filed on is/are: a) accep	oted or b) $\square$ objected to by the Ex	caminer.					
	Applicant may not request that any objection to the dr	awing(s) be held in abeyance. See 3	37 CFR 1.85(a).					
11) 🗆 -	Replacement drawing sheet(s) including the correction	n is required if the drawing(s) is object	cted to. See 37 CFR 1.121(d).					
	The oath or declaration is objected to by the Exa	Tiller. Note the attached Office A	ction or form PTO-152.					
	nder 35 U.S.C. § 119							
a)L	Acknowledgment is made of a claim for foreign portion and a claim for foreign portion. All borders are the companies of the control of the c		d) or (f).					
	<ol> <li>Certified copies of the priority documents to Certified copies of the priority documents to Certified copies.</li> </ol>	nave been received.						
	— Proof of the phoney documents i	have been received in Application	ı No					
	3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).							
* S	ee the attached detailed Office action for a list of	the certified copies not received						
	, seemen as a not of	and dopied flot received.						
ttachment(	•							
Notice	of References Cited (PTO-892) of Draftsperson's Patent Drawing Review (PTO-948)	4) Interview Summary (P	ΓΟ-413)					
l 🔲 Informa	ation Disclosure Statement(s) (PTO-1449 or PTO/SR/08)	Paper No(s)/Mail Date.  5) Notice of Informal Pate	nt Application (PTO-152)					
Paper I	NO(S)/Maii Date	6) Other:						
DL-326 (Rev	demark Office  V. 1-04)  Office Assiss							

## DETAILED ACTION

## Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- Claims 1-9, 18-22, 27-28, drawn to a microfluidic device and method of using device, classified in class 422, subclass 99.
- II. Claims 10-17, drawn to a microfluidic sorting device, classified in class 422, subclass 68.1.
- III. Claims 23-26, drawn to a sorting method, classified in class 210, subclass 767.
- IV. Claims 29-33, drawn to a method for dampening, classified in class 137, subclass 14.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and IV are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case process as recited can be practiced by another materially different apparatus, including flow channels which

Application/Control Number: 09/970,122

Art Unit: 1753

differ from the flow channels claimed in the apparatus, i.e., microfluidic flow channels.

Inventions II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process can be practiced by another materially different apparatus, such as large flow channels, whereas the apparatus is limited to microfluidic devices.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the damper required in the subcombination is not recited in the independent claims but is in a dependent claim. The subcombination has separate utility such as a fluid transport.

Application/Control Number: 09/970,122

Art Unit: 1753

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, III, or IV, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arun 5. Phasge whose telephone number is

Art Unit: 1753

(571) 272-1345. The examiner can normally be reached on MONDAY-THURSDAY, 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam X Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Arun S. Phasge

Primary Examiner

Art Unit 1753